

REMARKS:

The Official Action of May 5, 2008, and the prior art relied upon therein have been carefully reviewed. The claims in the application remain as claims 1, 2, 5, 20, 24, 26-38, 48 and 60, and these claims define patentable subject matter warranting their allowance. The applicant therefore respectfully requests favorable reconsideration and allowance.

Acknowledgement by the PTO of the receipt of applicant's paper ~~4~~s filed under §119 is noted.

Claims 1, 2, 5, 24, 26-31, 37, 38, 48 and 60 have been rejected under §102 as anticipated by the applicant's earlier US Patent 6,283,934 (Borgesen '934). This rejection is respectfully traversed.

First, applicant respectfully disagrees with the statement that Borgesen '934 "discloses the method as claimed by applicant." The only method claims are claims 48 and 60, and both of these claims require as a first step "providing a shunt system according to claim 1," Borgesen '934 does not disclose such a step because Borgesen '934 does not disclose the shunt system of claim 1.

As regards the shunt system claims, the rejection appears to be based on assumed inherency, the rejection stating near the bottom of page 3 as follows:

Since Applicant discloses that the apparatus may be made of various inert biocompatible materials (see applicant's 2007/0112291, paragraph 0091), it is the position of the Examiner that Borgensen's disclosure of the same materials meets the limitations of the claim.

The PTO may not properly base a rejection on inherency unless the PTO shows "some reasonable certainty of inherency" *In re Brink*, 164 USPQ 247. Also see *Ex parte Cyba*, 155 USPQ 756, 757 (1967); *In re Oelrich*, 212 USPQ 323,326 (1981).

As stated in *Ex Parte Levy*, 17 USPQ 2d 1461, 1463-64 (BPAI 1990):

In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teaching of the applied prior art. [citations omitted; emphasis in the original]

Please also see *In re Robertson*, 49 USPQ2d 1949, 1951 (*Fed. Cir.* 1999):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [citations omitted]

There is no reasonable certainty that the materials of Borgesen '934 inherently meets the features of the last paragraph of claim 1, and thus the rejection must fall on this basis alone.

Moreover applicant's claims are directed to a shunting system wherein the **surface** of the ventricle catheter, the sinus catheter or the shunt body is **coated** with a plurality of charged species. Such a coating is not disclosed in Borgesen '934, and thus Borgesen '934 also does not anticipate this feature of applicant's claims.

While no rejection has been imposed under §103, and applicant agrees that the claimed subject matter would not have been obvious, applicant further notes that such coating has the effect of increasing the hemocompatibility of the coated surface. It has surprisingly been found by the applicant that the coated shunt system of the present invention significantly reduces some of the problems associated with currently known shunts such as pointed out at page 10, lines 22-27 of the present specification. It is furthermore envisaged that shunt infection may be significantly reduced by such a coating (see page 10, line 29, through page 11, line 8 of the applicant's specification).

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1, 10 and 34-47 have been rejected under §102 as anticipated by the applicant's prior publication 2002/0045847 (Borgesen '847). This rejection is also respectfully traversed.

Again, this rejection (as the rejection under Borgesen '934) is based on assumed inherency, noting the top paragraph on page 6 of the Office Action. Accordingly, the same points raised above relative to the rejection based on Borgesen '934 are applicable to this rejection, and are therefore respectfully repeated by reference.

Briefly, there is no reasonable certainty as regards the materials. Second, Borgesen '847 also does not disclose a coating involving a plurality of charged species.

Withdrawal of the rejection is in order and is respectfully requested.

There is some ambiguity as to whether claims 32 and 33 were rejected, as these are not included in the statement of the rejection based on Borgesen '934 or Borgesen '847. On the other hand, the body of the rejection based on Borgesen '847 seems to include claims 32 and 33 in the paragraph spanning pages 6 and 7, even though these claims are not listed in the statement of the rejection. Applicant respectfully requests clarification.

As regards the prior art documents of record which have not been applied against any of applicant's claims, applicant understands that these documents are deemed by the PTO to be insufficiently material to warrant their application

against any of applicant's claims, and applicant is proceeding in reliance thereof.

Applicant believes that all issues raised in the Official Action have addressed above in a manner which should lead to patentability of the present invention. Accordingly, favorable consideration and early formal allowance are respectfully requested.

Respectfully submitted,

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